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OFFICE OF PETITIONS

In re Application of
Paul D. Coleman et al
Application No. 10/821,653
Filed: April 9, 2004
Attorney Docket No. 21108.0060U4

DECISION DISMISSING PETITIONS
UNDER 37 CFR 1.78(a)(3) AND (a)(6)

This is a decision on the petition filed February 12, 2007, which is being treated as a petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed nonprovisional and provisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and (iii) and 1.78(a)(5)(i) and (iii) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

Any nonprovisional application that directly claims the benefit of a provisional application under 35 U.S.C. § 119(e) must be filed within twelve months from the filing date of the provisional

application. An application that itself directly claims the benefit of a provisional application should identify, but not specify the relationship to, the provisional application. If the subject nonprovisional application is not filed within the twelve month period, however, it still may claim benefit of the provisional application via an intermediate nonprovisional application under 35 U.S.C. § 120. The intermediate nonprovisional application must have been filed within twelve months from the filing date of the provisional application and the intermediate nonprovisional application must have claimed the benefit of the provisional application. Further, it must be clearly indicated that the intermediate nonprovisional application is claiming the benefit under 35 U.S.C. § 119(e) of the provisional application. This identification of the intermediate nonprovisional application is necessary so that the Office can determine whether the intermediate nonprovisional application was filed within twelve months of the filing date of the provisional application, and thus, whether the benefit claim is proper.

The amendment to the specification states:

This application is a continuation-in-part of U.S. Serial No. 09/178,170 ~~09/770,534~~ filed January 25, 2001, which is a continuation of U.S. Serial No. 09/178,170, filed October 23, 1998, which claims the benefit of U.S. Serial No. 60/063,274, filed on October 24, 1997 (now expired) and U.S. Serial No. 60/179,214 filed January 31, 2000 (now expired). The disclosures of the prior applications are incorporated by reference in their entirety in the disclosure of the present application.

The wording of this claim for benefit of priority is improper since the claim, as presented, states that Application No. 09/178,170 claims benefit to a later-filed provisional application; namely, provisional Application No. 60/179,214, which was filed on January 31, 2000. It would be more appropriate for Application No. 09/770,534 to claim benefit of priority to provisional Application No. 60/179,214, as Application No. 09/770,534 was filed within 12 months from the filing date thereof. However, a review of Application No. 09/770,534 fails to disclose that a claim for priority was ever made to provisional Application No. 60/179,214. Petitioner is advised that, where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. *See Sampson v. Ampex Corp.*, 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); *Sticker Indus. Supply Corp. v. Blaw Knox Co.*, 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); *Hovlid v. Asari*, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). *See also* MPEP § 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP Section 201.06(d). Accordingly, it would be improper here for petitioner to claim priority to provisional Application No. 60/179,214. Petitioner may wish to consider filing a petition to revive under the unintentional provisions of 37 CFR 1.137(b) in Application No. 09/770,534 solely for the purpose of filing a petition under 37 CFR 1.78(a)(6) to accept a late claim for benefit of priority to provisional Application No. 60/179,214.

Further, the reference to add prior-filed Application No. 09/770,534 in the first sentence of the specification on page one following the title is not acceptable as drafted since it improperly incorporates this prior-filed application by reference. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

If reconsideration of this decision is requested, a renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) (no additional petition fee is required) must be submitted, along with an amendment or a Supplemental Application Data Sheet complying with the provisions of 37 CFR 1.121 which overcomes the above-noted problems. If a Supplemental Application Data Sheet is submitted, it must be executed in accordance with 37 CFR 1.33(b).

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Irvin Dingle at (571) 272-3210.

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